

REMARKS

This invention relates to compositions containing high-molecular weight siloxanes with multiple (meth)acrylate functional groups and reinforcing fillers, which can be crosslinked by radiation to give elastomeric coatings useful for a variety of applications.

The Examiner is thanked for the indication that claims 7, 12, 13 and 18 contain allowable subject matter.

It is believed that no fee is required for the consideration of this Amendment. If, however, a fee is due, the Director is authorized to charge such fee to Deposit Account No. 50-0320.

This Amendment amends claim 1 and cancels claim 9. The purpose of this Amendment is to define more precisely the subject matter Applicants claim as their invention. Therefore, this Amendment does not create estoppel. Support for the changes in claim 1 are found on page 10, lines 6 to 9, and in original claim 9. Thus, no new matter is added.

Applicants affirm their election of the invention of Group I, claims 1 to 22. Applicants respectfully traverse this rejection and request its modification or removal. Applicants urge that the Restriction Requirement is improper since it does not establish that searching all the claims constitutes an undue burden and because it is contrary to public policy.

The MPEP lists two criteria for a proper restriction requirement. First, the invention must be independent or distinct. MPEP § 803. Second, searching the additional invention must constitute an undue burden on the examiner if restriction is not required. *Id.* The MPEP directs the examiner to search and examine an entire application “[i]f the search and examination of an entire application can be made without serious burden, ... even though it includes claims to

distinct or independent inventions.” *Id.* Hence, alleging distinctness alone is not enough to establish a proper restriction requirement.

Applicants urge that the Restriction Requirement does not meet the second of these criteria as the search for both inventions overlaps. The reason for this is that organosiloxanes recited in Groups II to IV are subgeneric to the organosiloxanes claimed in Group I. Thus, a search of the invention of Group I overlaps the search for the inventions of Groups II to IV. The fact that all the groups are searched in the same class and subclass support this position. Moreover, while the Office Action alleges that the inventions contained in the various groups “are distinct and capable of supporting their own patent,” the Office Action does not provide any evidence to support this position.

Further, it is respectfully urged that restricting the claims in the manner suggested in the Restriction Requirement constitutes an undue burden to Applicants as well as the public. The cost of prosecuting and maintaining four patents is unreasonable in view of the fact that the four groups are so closely related. Further, the public is inconvenienced as they will not know whether or not Applicants will file a divisional application to the remaining subject matter. Accordingly, the public will not know if they can practice the remaining invention without infringing future patent application.

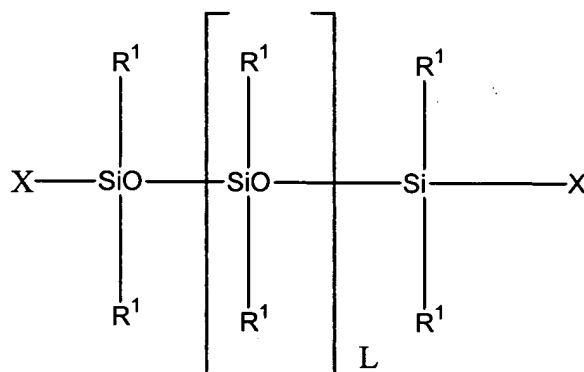
Accordingly, in view of the foregoing, reconsideration and modification of this restriction requirement is requested and an early action on the merits is earnestly solicited.

Claim 2 stands rejected under 35 USC §112, second paragraph for allegedly being indefinite. In view of the foregoing, reconsideration of this rejection is requested. The rejection argues that the claim is incomplete because b is not defined. However, b is defined in the claim from which it depends. Accordingly, it is urged that the claim is complete. If, however, the

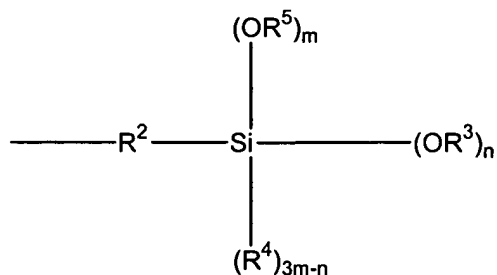
Examiner insists on inserting a definition of b into claim 2, they will do so as it does not effect the scope of the claim.

Claims 1 to 5, 8, 16, 17 and 19 to 22 stand rejected under 35 USC §102(b) for allegedly being anticipated by Okinoshima et al., U.S. 6,069,186 ("Okinoshima"). As Okinoshima does not teach siloxane wherein the acrylate radical(s) are attached to the siloxane framework by way of Si-C bonds, the patent cannot anticipate the invention as claimed. Further, it should be noted that the compound taught in column 16 cannot anticipate the invention as claimed since its corresponding value for b is 131, which does not fall within the range of 800 to 10,000 provided for in the claims.

Okinoshima discloses organopolysiloxanes of the formula



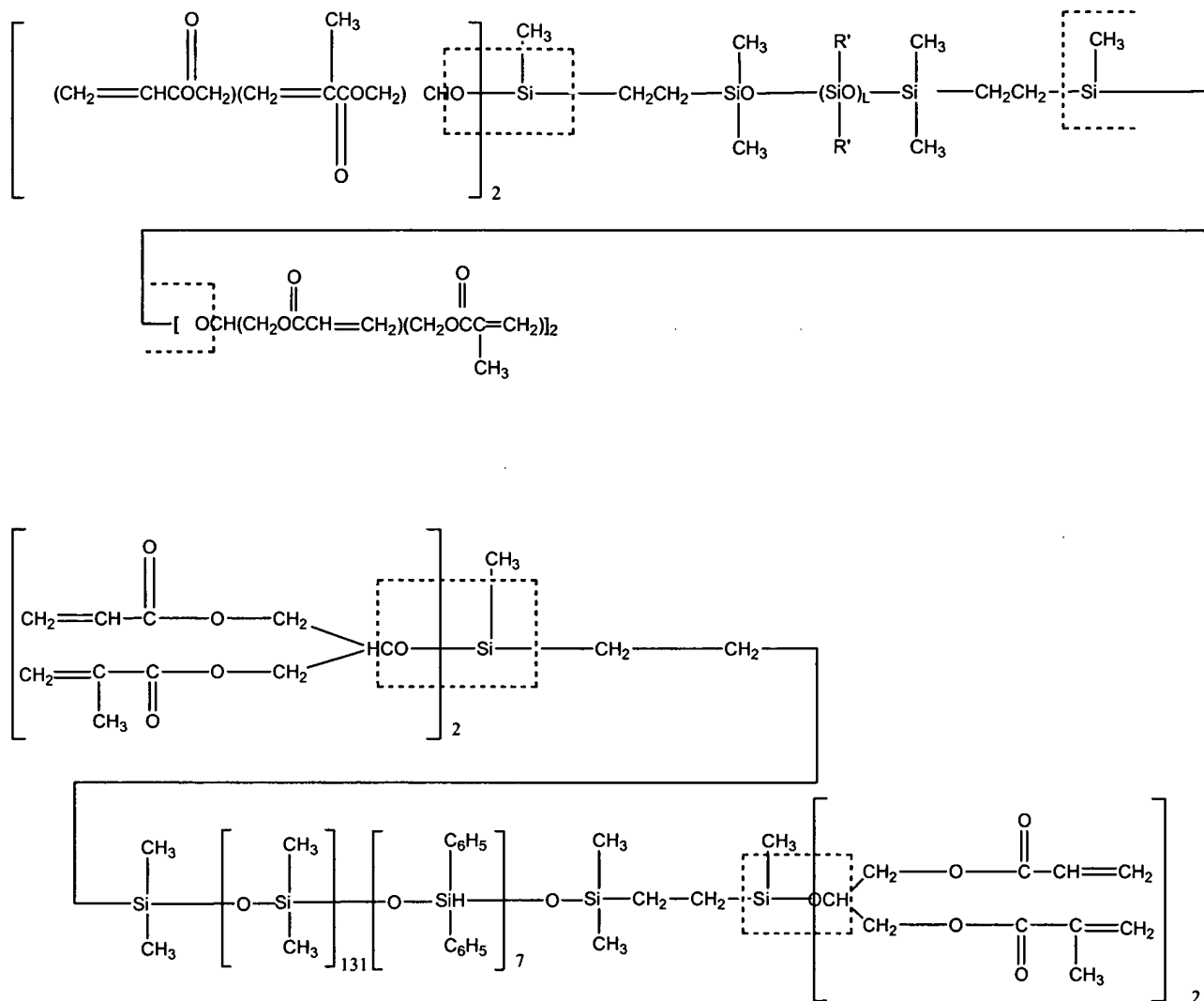
wherein X is



and R^3 is a monovalent organic group having 4 to 25 carbon atoms, which has 1 to 3 acryloxy or methacryloxyl groups attached (see col.1, lines 45-67). Thus, the functionality connecting the

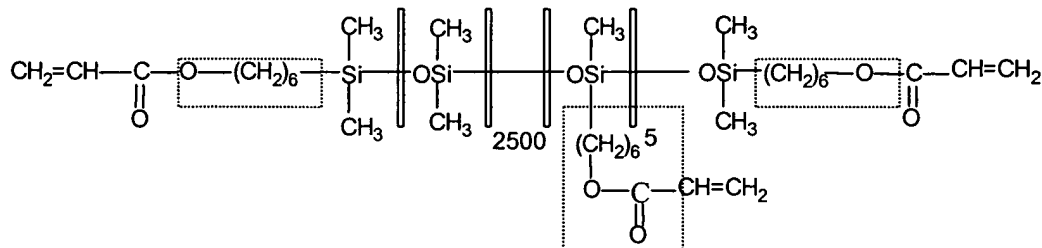
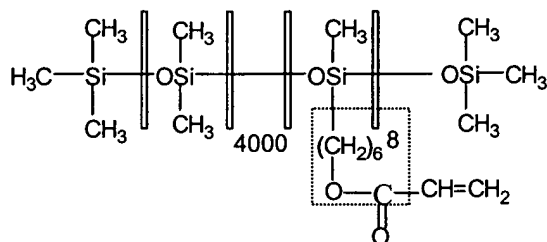
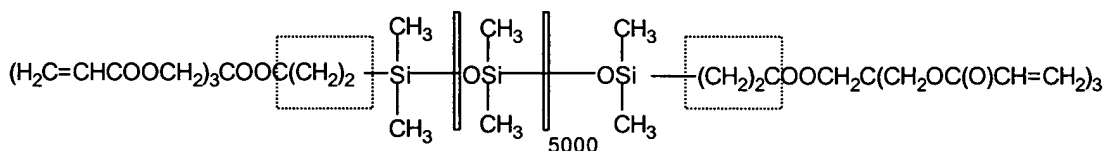
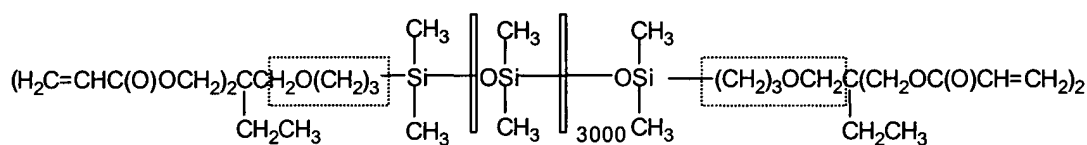
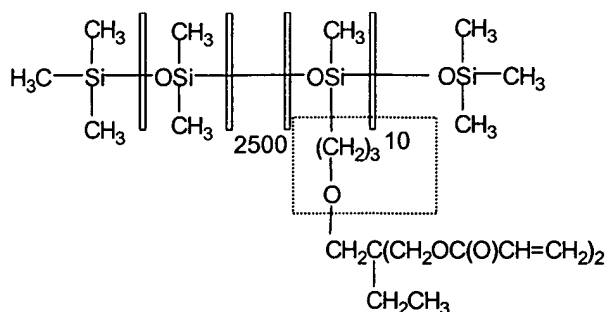
(meth)acrylate groups to the rest of the polymer is a -SiOC- linkage. This may be seen, for example in formula (1-1) and the compound depicted in column 16 that is discussed in the rejection. These structures are reproduced below with the -SiOC- bonds highlighted.

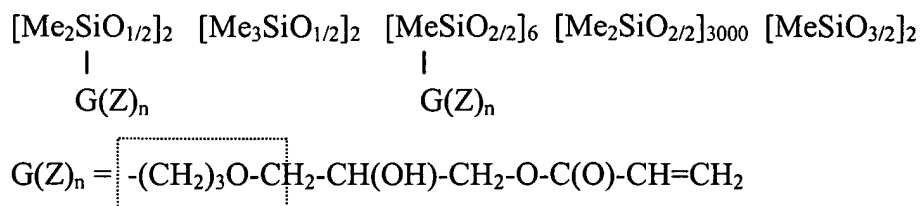
(1-1)



The (meth)acrylate groups in the high-molecular weight siloxanes (a) of the present invention are not connected to the rest of the polymer backbone -SiOC- bonds. As indicated in

the specification, the (meth)acrylate radical(s) are attached to the siloxane framework by way of Si-C bonds. The element in the claim that ensures this is the definition for G. This may be seen in the siloxane polymer exemplified in the specification on pages 11 and 12, which are produced below:

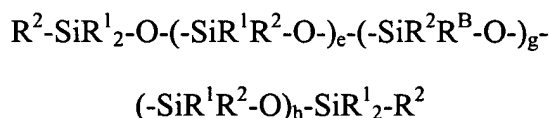




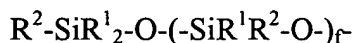
Thus in view of the foregoing, it is clear that Okinoshima does not anticipate the present claim and reconsideration and withdrawal of this rejection is requested.

Claims 1 to 6, 9 to 11, 14, 16 and 19 to 22 stand rejected under 35 USC §102(b) for allegedly being anticipated by Irifune et al. EP 0 624 627 ("Irifune"). Applicants respectfully disagree since Irifune does not teach the silicone resin recited as reinforcing fillers required in component b) of the present claims.

Irifune discloses a two component radiation-curable organopolysiloxane composition that comprises as a uniform blend two organosiloxanes, the second of which has the following formula:



in which R^1 and R^2 each have the same meaning as defined above,
 R^B is an organosiloxy group represented by the general formula



the groups denoted by R^2 including the ω -(meth)acryloxyalkyl groups represented by the general formula (II) given above.

(p. 3, lines 5 to 16). Importantly, the index g cannot exceed 3, thereby limiting the branching in the molecule (see p. 3, line 18). In terms of the nomenclature in the art, the organosiloxanes of formula IV are primarily D units (see Noll, copy attached) and where branching is possible, the

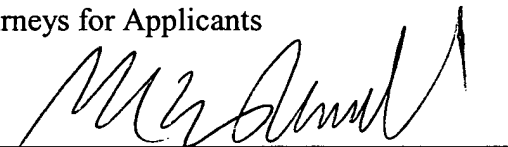
branching is limited to no more than 3 because of the index g. Hence, the organosiloxanes disclosed in Irifune are essentially linear, with only a minimal amount of branching.

The organosiloxanes in Irifune stand in contrast to the ones provided for in claim 1. The silicone resin recited in claim 1 are highly branched, providing for crosslinking. The reasons for this is that the formula is for a MMTTQ polysiloxane, where branching occurs on the T and Q groups. Hence, as the polysiloxanes are completely different, Irifune cannot anticipate the claims. Hence, reconsideration and withdrawal of this rejection are requested.

Favorable action is earnestly solicited.

Respectfully submitted,

FROMMER LAWRENCE & HAUG LLP
Attorneys for Applicants

By: 
Mark W. Russell
Reg. No. 37,514
(212) 588-0800